

Remarks

1. Summary of the Office Action

In the office action mailed October 5, 2011, the Examiner rejected claims 4, 5, and 26 under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 6,421,733 (Tso) in view of U.S. Patent Application Pub. No. 2003/0187806 (Banerjee), and the Examiner rejected claims 13-19 under 35 U.S.C. § 103(a) as being allegedly obvious over Banerjee in view of Tso. Further, the Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being allegedly obvious over Tso and Banerjee in view of U.S. Patent Application Pub. No. 2003/0083041 (Kumar).

2. Status of the Claims

Applicant has cancelled claims 13, 16-19 and 26.

Applicant has amended claim 14 to incorporate the limitations of claim 4 and to be written in independent form, and Applicant has amended claim 15 to depend from claim 14 instead of from now-cancelled claim 13, and to remove the word "referenced" so as to provide proper antecedent basis. Further, Applicant has added new claims 27 and 28 depending from claim 14, paralleling the language of dependent claims 5 and 6.

Applicant has added new claim 29, combining together the limitations of claim 4 and claim 17. And Applicant has added new claims 30-32, paralleling the language of dependent claims 5, 6, and 15 (with the word "referenced" removed).

Further, Applicant has added new claim 33, depending from claim 4 and paralleling the language of claim 15 (with the word "referenced" removed).

Now pending are claims 4-6, 14-15, and 27-33, of which claims 4, 14, and 27 are independent and the remainder are dependent.

3. Interview Summary

On January 3, 2012, the undersigned held a telephone interview with Examiner Michael Lai, at the request of the undersigned. During the interview, we discussed how claim 4 patentably distinguishes over the cited art, as summarized by the remarks below. The Examiner indicated that he would consider these remarks and would contact the undersigned if any minor issues remain. The undersigned expressed Applicant's hope that we can resolve this case after extensive prosecution now spanning eleven office actions, particularly given Applicant's willingness to focus the issues by cancelling some of the independent claims that were pending before this response. (Applicant reserves the right to pursue the subject matter of those claims, and other subject matter of this case, in one or more continuation applications.)

Applicant thanks the Examiner for his time and consideration of this matter.

4. Response to the Rejections

Applicant respectfully submits that the rejection of independent claim 4 as being allegedly obvious over Tso in view of Banerjee was improper and should be withdrawn, because the Examiner did not make out a *prima facie* case of obviousness as required by M.P.E.P. § 2142 (indicating that, to establish *prima facie* obviousness, an Examiner must clearly articulate reasoning with rational underpinning to support the conclusion of obviousness).

In rejecting claim 4, the Examiner admitted that "Tso does not disclose: the intermediation system (i.e., proxy 36) computing a size-based cost to access the received web content; the intermediation system engaging in interstitial communication with the client station to receive user approval to pay the computed size-based cost; and after receiving the user approval, the intermediation system sending the web content along the communication path to the client station." (See office action at pages 3-4 (emphasis in original)).

The Examiner then made some allegations about Banerjee's teachings and expressed the belief that it would have been obvious to incorporate Banerjee's teaching into Tso's method "for the purpose of extending Tso's transcoding capability to manage payment for web content by dynamically calculating and displaying the cost of downloading web content based on content size, thereby reaching agreement for payment with users before users receiving the requested web content." (*See* office action at page 5.)

This analysis by the Examiner, however, did not establish *prima facie* obviousness of the invention particularly recited by claim 4 but rather only established the Examiner's position that it would have been obvious to incorporate Banerjee's teaching into Tso's method as a general matter. Yet merely incorporating Banerjee's teaching into Tso's method as a general matter does not explain how or why one of ordinary skill in the art at the time of Applicant's invention would have been reasonably led to achieve Applicant's invention.

Considering the office action more specifically, it seems clear that the Examiner relied on Banerjee's teaching of functions carried out by the client station as the Examiner has done in the past, notwithstanding the fact that Applicant's claims quite specifically involve functions carried out by an intermediation system while the web content is in transit from the content server to the client station and has at a time when the web content has left the server but has not yet arrived at the client station. Banerjee's teaching of a client station carrying out particular functions with respect to content that the client station has received from a server not only does not suggest an intermediation system carrying out those particular functions while the content is in transit from the server to the client station and has thus not yet arrived at the client station, but further does not suggest the intermediation system sending the content along the communication path to the client station after the intermediation system carries out those particular functions.

On this point, in the office action, the Examiner generally contended that Banerjee teaches "after receiving the user approval, sending the web content along to the client station". (See office action at page 4, citing paragraphs 0024 and 0025 of Banerjee where Banerjee teaches a user clicking.) Yet the Examiner made this contention notwithstanding the fact that claim 4 specifically recites, *after the content has left the content server but before the web content has yet arrived at the client station, the intermediation system sending the web content along the communication path to the client station.*

Of course, Banerjee's teaching at paragraphs 0024 and 0025 does indeed provide for a user approving download of content by clicking a link, as the Examiner seems to have noted. But that user approval is not received through interstitial communication between an intermediation system and the client station as recited by claim 4.

Furthermore, the Examiner erred in asserting that Banerjee teaches "engaging in interstitial communication with the client station to receive user approval to pay the cost" at the abstract and in paragraphs 0060 and 0065. Claim 4 specifically recites the intermediation system engaging in interstitial communication with the client station to receive user approval to pay the computed size-based cost. Yet the cited teachings of Banerjee relate to a client station determining the download cost, rather than to an intermediation system engaging in interstitial communication with the client station to receive user approval to pay the computed size-based cost. Moreover, that feature of claim 4 cannot be met by this teaching of Banerjee, because claim 4 specifically recites *the intermediation system engaging interstitial communication with the client station* to receive the user approval before the intermediation system sends the content along the communication path to the client station *after receiving the user approval.*

Applicant wonders if the Examiner was reading Banerjee's "second web page" as being the web content at issue, and was attempting to rely on paragraph 0060 of Banerjee, where Banerjee teaches that a "first web page" includes a download cost markup element for the second web page. Perhaps the Examiner would note that the "second web page" whose cost is indicated in the first page is not yet received by the client station according to that teaching, and so the Examiner would argue that the second web page would meet the "web content" limitation of claim 4. But this interpretation also could not be correct. Claim 4 specifically recites that the intermediation system receives the web content, that the intermediation system computes a size-based cost to access that received web content, and after receiving user approval to pay the computed size-based cost, the intermediation system sends the content along to the client station. The entity in Banerjee that determines download cost (namely, the client station) for the second web page has not yet received the second web page when it makes that determination, so that teaching of Banerjee cannot meet the limitations of claim 4.

During the interview held January 3, 2012, the Examiner seems to have expressed the view that the combination of Tso's intermediation on web content and Banerjee's determination of size-based cost and receiving of user approval to download content amounts to the invention of claim 4. In particular, it seems the Examiner's thought was that (i) Banerjee teaches a client station determining size-based cost and receiving user approval to download content, (ii) Tso teaches an intermediary modifying web content that is in transit to a client station, and (iii) it would be obvious to apply Banerjee's functions within Tso's intermediary. But as the undersigned explained during the interview, merely applying Banerjee's functions within Tso's intermediary would not result in the invention recited by claim 4.

At best, if one were to apply Banerjee's functions within Tso's intermediary, for sake of discussion, the result might be that Tso's intermediary would determine size based cost for content and a user would click on a link presented by the intermediary (e.g., by a browser run on the intermediary instead of a browser run on the client station). But what would still be missing would be the intermediation system engaging in interstitial communication with the client station to obtain user approval to pay the computed size-based cost (before the intermediation system sends the web content along the communication path to the client station) as recited by claim 4.

As the undersigned explained in the interview, the third indented clause of claim 4 is made up of at least two parts: (i) the intermediation system engage in interstitial communication with the client station, and (ii) the intermediation system receiving user approval to pay the computed size-based cost. (The clause integrally combines these two parts together as "the intermediation system engaging in interstitial communication with the client station to receive user approval to pay the computed size-based cost". Further, this feature is functionally interrelated with those the claim recites before it and after it, as the feature refers to the computed size-based cost (introduced in the preceding feature), and the feature introduces receiving user approval (applied in the next feature)).

If one were to have had Tso's intermediary apply Banerjee's teaching of receiving user approval to download content, even user approval to download content with a particularly determined size-based cost, the result would have been *at best* that Tso's intermediary would receive user approval to download content, or user approval to download content with a particularly determined size-based cost. But what would still be missing is the actually recited feature of claim 4 (including its integral relationship with the features recited before and after it) of "the intermediation system engaging in interstitial communication with the client station to

receive user approval to pay the computed size-based cost", as there would be no suggestion to have *Tso's intermediation system engage in interstitial communication with the client station* to receive the user approval. Indeed, it would take quite a jump of logic to modify Tso's disclosure so as to have the intermediation system carry out such interstitial communication with the client station. And the cited art does not seem to suggest such a change.

For at least these reasons, Applicant respectfully submits that *prima facie* obviousness of claim 4 over Tso in view of Banerjee has not been established. Consequently, Applicant submits that claim 4 should be allowed. Further, Applicant submits that the claims depending from claim 4 should be allowed as well for at least the same reasons.

Applicant also submits that independent claims 14 and 27, and their dependent claims, should be allowed for at least the same reasons that claim 4 should be allowed.

Applicant therefore respectfully requests reconsideration and allowance of the claims.

Applicant does not acquiesce in any assertion in the office action that is not expressly addressed by these remarks.

Should the Examiner wish to discuss this case further, the Examiner is invited to call the undersigned at (312) 913-2141.

Respectfully submitted,

**MCDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Date: January 5, 2012

By: /Lawrence H. Aaronson/
Lawrence H. Aaronson
Reg. No. 35,818